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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,300	02/14/2005	Jean-Marie Adam	HC/1-22736/A/PCT	5992

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CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
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TARRYTOWN, NY 10591-9005

EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/525,300

Applicant(s)

ADAM ET AL.

Examiner

Eisa B. Elhilo

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7 is/are rejected.
- 7) ☒ Claim(s) 4-6, 8-14 and 16-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/14/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1 This action is responsive to the applicant's election received by the office on September 01, 2006. Election of claims 1-14 and 16-19 is acknowledged. Claim 15 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Therefore, claims 1-14 and 16-19 are pending in this application.

2 The information disclosure statement filed on February 14, 2005, has been considered. The foreign references are not in the file and are not available to the examiner to be reviewed. Accordingly, these references are not considered by the Examiner. Applicants may file copies of these references with the response of this office action for further reviewing and consideration by the examiner.

Claim Rejections - 35 USC § 112

3 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-3 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3 and 7 are indefinite because the claims recite formulae (2) and (3) with a letter (A) in side the benzene rings. It is unclear what radical or substituent represented by the letter (A). No guidance provided by specification. Clarification is required.

Double Patenting

4 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

Art Unit: 1751

is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,041,143 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the US. Patent No. 7,041,143 B2, teaches and discloses a similar method for coloring hair (porous material) comprising applying to the hair being colored in any order successively or simultaneously a capped diazonium compound of a cyclic triazene of formulae (4) and (5) which are similar to the claimed formulae (2) and (3) and a water-soluble coupling component as claimed in claim 1 (see claim 1, of the US patent No. 7,041,143 B2). Therefore this is an obvious formulation.

Although, claim 1, of the US. Patent No. 7,041,142 B2, teaches and discloses similar method for dyeing porous material (hair), the claims are not identical because claim 1, of the US. Patent No. 7,041,142 B2, requires an alkaline condition, while the instant claim does not require an alkaline condition. Therefore, the conflicting claims are not identical.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to be motivated to utilize such a method for coloring porous material (hair) by applying to the hair a composition that comprises the combination of the capped diazonium compounds and the water-soluble coupling component in a suitable medium to arrive at the claimed invention because claim 1, of the US. Patent clearly such a combination diazonium compounds and coupling components for coloring hair, and, thus, a person of the ordinary skill in the art would expect such a process to have similar properties to those claimed, absent unexpected results.

5 Claim 1 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/525,469.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the copending application No. 10/525,469, teaches and discloses a similar method for coloring porous material comprising applying to the material being colored in any order successively or simultaneously a capped diazonium compounds of formulae (3), (4) and (5) which are similar to the claimed formulae (1), (2) and (3) and a water-soluble coupling component as claimed in claim 1 (see claim 1, of the copending Application No. 10/525,469). Therefore this is an obvious formulation.

Although, claim 1, of the copending application No. 10/525,469, teaches and discloses similar method for dyeing porous material, the claims are not identical because claim 1, of the US. Copending Application No. 10/525,469, requires at least one cationic water-soluble aromatic coupling component while the instant claim does not require specific cationic coupling component. Therefore, the conflicting claims are not identical.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to be motivated to utilize such a method for coloring porous material by applying to the material a composition that comprises the combination of the capped diazonium compounds and any water-soluble coupling component to arrive at the claimed invention because claim 1, of the copending Application No. 10/525,469, clearly such a combination of diazonium compounds and coupling components for coloring porous materials, and, thus, a person of the ordinary skill in the art would expect such a process to have similar properties to those claimed, absent unexpected results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

6 Claims 4-6, 8-14 and 16-19 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record do not teach or disclose the limitations (Q, R and T) of the diazonium compounds of the claimed formulae (1), (2) and (3) in a combination with at least one water-soluble coupling component as claimed.

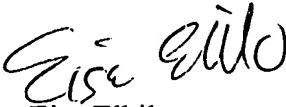
Conclusion

7 The US references listed on from PTO-1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Eisa Elhilo
Primary Examiner
Art Unit 1751

September 24, 2006